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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,867	10/31/2003	David R. Hall	66.0039	2866
38046	7590	04/25/2006	EXAMINER	
JEFFREY E. DALY INTELLISERV, INC 400 N. SAM HOUSTON PARKWAY EAST SUITE 900 HOUSTON, TX 77060			HEWITT, JAMES M	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/605,867		HALL ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	James M. Hewitt		3679	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/1/05 & 1/30/06.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The specification is indicated as being filed on 10/31/05, not 10/31/03.

### ***Claim Objections***

Claims 18-32 are objected to because of the following informalities:

Claims 18-27 and 29-31 should depend from claim 17, and not from claim 1.

Claim 28 should depend from claim 27, and not from claim 11.

Claim 32 is objected to under 37 C.F.R. 1.75(i), which states "Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation."

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-18, 20-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Denison et al (US 4,095,865).

With respect to claim 17, Denison et al discloses a downhole component (comprising pipe sections 1 and 1a), comprising: a tube (1a) having an inside diameter (19) and an elongate, generally cylindrical tool joint (1) comprising a first interfacial surface (7 or female threads) and having a wall; an upset formed on an end of the tube (1a) comprising a second interfacial surface (8 or male threads) and having an effective inside diameter (as at 18 in the pin) less than the inside diameter (19) of the tube (1a); the tool joint (1) being attached to the upset on the tube (1a) at the first and second interfacial surfaces (abutment shoulders or threads) and the tool joint also being adapted for connection (as by male threads) to an adjacent tool and an opening (13) formed within the wall of the tool joint in alignment (via 37 in tool joint) with a passageway (12 and 37) formed in the upset; wherein the opening and the passageway allow passage of a transmission line between the tool joint and the tube.

Denison et al's opening (13) formed within the wall of the tool joint is also considered to be in alignment (along a longitudinal axis) with a passageway (12 and 37)

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formed in the upset when the pipe sections (1, 1a) are joined as the sections (1, 1a) are identical and symmetric.

With respect to claim 18, wherein the passageway formed in the upset is provided by varying a thickness of the upset. Refer to Figure 2. The diameter of the passageway varies, and thus the thickness of the upset varies.

With respect to claim 20, wherein the passageway formed in the upset is provided by at least a portion of the upset having a thickness that is less than the tool joint bore wall thickness at the first and second interfacial surfaces between the tool joint and the upset. Refer to Figure 2.

With respect to claim 21, wherein the passageway formed in the upset comprises a circumferential chamfer (as at 16) in at least a portion of the upset.

With respect to claim 22, wherein the passageway formed in the upset comprises a spiral groove (as by one of the thread grooves of 34) in at least a portion of the upset.

With respect to claim 23, wherein the passageway formed in the upset comprises a circumferential groove (as at 16) in at least a portion of the upset.

With respect to claim 24, wherein the passageway formed in the upset comprises an axial groove in at least a portion of the upset.

With respect to claim 25, wherein the passageway formed in the upset comprises an internal passageway intersecting the second interfacial surface and a transition surface (as at 16) of the upset.

With respect to claim 26, wherein the passageway formed in the upset comprises one or more external passageways (as at 24) intersecting at the second interfacial surface and a transition surface (as at 16) of the upset.

With respect to claims 27 and 28, as the method of forming the device is not germane to the issue of patentability of the device itself, the claims fail structurally distinguish from Denison et al.

With respect to claim 29, wherein the passageway formed in the upset allows passage of a transmission line that is in communication with a transmission coupler (25) located in the tool joint and is part of a downhole network for electrical transmission between downhole equipment and surface equipment.

With respect to claim 30, wherein the component is selected from the group consisting of drill pipe, heavyweight drill pipe, sub-assemblies, and drill collars.

With respect to claim 31, wherein the component is selected from the group consisting of drill bits, drill motors, logging while drilling tools, hole openers, stabilizers, under-reamers, rotary steerable systems, drilling jars, drilling shock absorbers, drilling turbines, sensor packages, and measuring while drilling tools.

With respect to claim 32, Denison et al discloses a downhole component (comprising pipe sections 1 and 1a) comprising a tube (1a) with at least one passageway (12) formed in an upset that cooperates with an opening (13) in a tool joint (1) such that when the tube and the tool joint are joined together, the passageway in the tube and the opening in the tool joint allow the passage of a transmission line from the

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tool joint to the tube wherein the tool joint is adapted for connection (via threads) to an adjacent tool when the tool joint and the tube are joined together.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denison et al (US 4,095,865).

Denison et al fails to teach that the passageway is provided by forming the effective inside diameter of the upset eccentric from a longitudinal axis of the tool joint. It would have been an obvious matter of design choice to form the effective inside diameter of Denison et al's upset eccentric from a longitudinal axis of the tool joint.

Applicant offers such a modification as a mere design alternative and fails to provide any significant purpose or unexpected results that arise from such a modification.

***Response to Arguments***

Applicant's arguments filed 1/30/06 with respect to Denison et al have been fully considered but they are not persuasive.



With respect to claim 17, Applicant asserts "Denison et al (US 4,095,865) does not teach or disclose a tool joint being attached to the upset on the tube at the first and second interfacial surfaces, the tool joint also being adapted for connection to an adjacent tool, and that an opening formed within the wall of the tool joint is in alignment with a passageway formed in the upset." The Examiner disagrees. Refer above to the interpretations/explanations provided with respect to the rejection of claim 17.

With respect to claim 32, Applicant asserts, "Claim 32 also includes that the tool joint is adapted for connection to an adjacent tool when the tool joint and the tube are joined together and that an opening formed within the wall of the tool joint is in alignment with a passageway formed in the upset, which is not taught or disclosed by Denison et al (US 4,095,865)." The Examiner disagrees. Refer above to the interpretations/explanations provided with respect to the rejection of claim 32. And note that the limitation "an opening formed within the wall of the tool joint is in alignment with a passageway formed in the upset" is not present in claim 32.

Applicant's arguments, see pages 8-9, filed 1/30/06, with respect to the 102 rejection in view of Papadopoulos have been fully considered and are persuasive. The rejection of the claims in view of Papadopoulos has been withdrawn.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

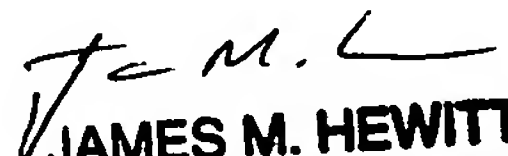
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Hewitt whose telephone number is 571-272-7084.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**JAMES M. HEWITT**  
**PRIMARY EXAMINER**